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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,886	06/17/2005	Jachwan Eun	DE1643	1951
1109 7590 09/14/2007 ANDERSON, KILL & OLICK, P.C. 1251 AVENUE OF THE AMERICAS NEW YORK,, NY 10020-1182			EXAMINER MAZUMDAR, SONYA	
			ART UNIT 1734	PAPER NUMBER
			MAIL DATE 09/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,886	Applicant(s) EUN ET AL.	
	Examiner Sonya Mazumdar	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005 and 15 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/17/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

With respect to claim 6, there is no disclosure in the specification of forming a conductive metal layer (70) on a substrate (40), before attachment to a single crystal plate (80) (Applicant's specification: page 7, lines 3-8; Figures 2c-2e).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 3, 9, 11, 12 and 13 are rejected under 35 U.S.C. 102(b) as being unpatentable by Kondo et al. (US 2002/0048076).

With respect to claim 1, 12, and 13, Kondo et al. teach preparing a traveling wave-type optical modulator by adhering a ferroelectric single crystal plate (1A – Fig. 1b, 4 – Fig. 1c) to a substrate (1B) with an epoxy-based resin film (3) (paragraphs 0021, 0022, 0056, 0064, and 0076; Figure 1b and 1c).

With respect to claim 2, Kondo et al. teach grinding and polishing a ferroelectric single crystal plate to a thickness of 10 μ m (column 9, lines 9-12).

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With respect to claim 9, Kondo et al. teach using a ferroelectric single crystal plate made of lithium niobate (LiNbO_3) or lithium tantalate (LiTaO_3) (paragraph 0039).

With respect to claim 11, Kondo et al. teach sputtering a conductive layer on a surface of a ferroelectric single crystal plate opposite to where an adhesive layer is disposed (paragraph 0060).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 3 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kondo et al., as applied to claim 1 above.

Although heating to bond a laminate of a ferroelectric single crystal and a substrate at room temperature is not specifically taught, it is inherent that one would do so using a resin curable at room temperature (paragraph 0022). However, if it is not inherent, it would have been obvious for Kondo et al. to do so to cure the resin without overheating the entire laminate.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al., as applied to claim 3 above, and further in view of Yachi et al. (US 5,925,968) and Durand et al. (US 5,183,593)

The teachings of claim 1 are as described above.

Kondo et al. do not teach using a conductive adhesive comprising gold, silver, or platinum. However, Durand et al. teach using an electrically conductive bonding cement, comprising gold or silver, to mate electrically conductive surfaces (Durand: abstract, column 1, lines 31-33); Kub et al. teach bonding piezoelectric or ferroelectric element to a substrate with an electrically conductive paste, such as silver paste (Kub: column 7, lines 25-29; column 10, lines 44-48; column 11, lines 62-64).

It would have been obvious to one having ordinary skill in the art to use a conductive adhesive, such as a gold or silver paste, as opposed to other adhesives and one would have been motivated to do so to form a strong and reliable bond between electrical components to provide an electron pathway (Durand: column 1, lines 39-45).

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7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al., as applied to claim 3 above, and further in view of Fujioka et al. (DE 4037271).

The teachings of claim 3 are as described above.

Kondo et al. do not specifically teach how adhesive is applied to a substrate. However, Fujioka et al. teach applying adhesive with a piston (1) that has plates (3, 4) equipped with a cylinder (11) having a compressive part at the forward end of the piston shaft (Fujioka: abstract; Figures 1-3).

It would have been obvious to use an application means as Fujioka et al. taught, and one would have been motivated to do so to have a simple and handheld application process and dispense adhesive linearly as the piston is moved (Fujioka: abstract).

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al., as applied to claim 1 above, and further in view of Yachi et al. and Durand et al.

The teachings of claim 1 are as described above.

Kondo et al. teach applying an adhesive layer (3) to both a ferroelectric single crystal plate (1A) and a substrate (1B) and bonding the laminate at under 600°C (column 2, lines 21-26; Figure 1b). Kondo et al. also teach forming a titanium layer (2) onto the ferroelectric single crystal plate (paragraph 0057; Figures 1a-1c).

Kondo et al. do not expressly teach applying a conductive metal to both surfaces and bonding the two. However, Durand et al. teach using an electrically conductive bonding cement, comprising gold or silver, to mate electrically conductive surfaces (Durand: abstract, column 1, lines 31-33); Kub et al. teach bonding piezoelectric or ferroelectric element to a substrate with an electrically conductive paste, such as silver paste (Kub: column 7, lines 25-29; column 10, lines 44-48; column 11, lines 62-64).

It would have been obvious to one having ordinary skill in the art to use a conductive adhesive, such as a gold or silver paste, as opposed to other adhesives and one would have been motivated to do so to form a strong and reliable bond between electrical components to provide an electron pathway (Durand: column 1, lines 39-45).

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al., Yachi et al., and Durand et al., as applied to claim 6 above, and further in view of Suenaga et al. (US 3,715,802)

The teachings of claim 6 are as described above.

Kondo et al. in view of Yachi et al. and Durand et al. do not teach inserting an intermediate metal layer between two conductive metal layers prior to bonding the layers. However, Suenaga et al. teach disposing tin solder between an electrode (379) and a diode element (377) (Suenaga: column 12, line 66 – column 13, line 3).

It would have been obvious to use a tin solder to bond two conductive layers, and would have been motivated to do so because the tin solder has a relatively low melting point, and thus the laminate does not to be heated at a high temperature to bond two layers together (Suenaga: column 13, line 3 and lines 30-35).

The specification discloses that tin (Sn) or a tin-alloy may be used as an intermediate metal layer (Applicant's specification: page 7, lines 18-22).

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al., as applied to claim 1 above, and further in view of Yasumoto et al. (US 4,772,985)

The teachings of claim 1 are as described above.

Kondo et al. do not specifically teach the dielectric constant of a ferroelectric film. However, Yasumoto et al. teach using ferroelectric crystal layer having a dielectric constant of 20,000 (Yasumoto: column 1, lines 23-24).

It would have been obvious for one to use a ferroelectric layer with such a dielectric constant in order to avoid signs of poor moisture resistance and poor migration resistance of electrode metals (Yasumoto: column 1, lines 32-36; column 5, lines 38-44).

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al., as applied to claim 1 above, and further in view of Kijima et al. (JP 09-186376)

The teachings of claim 1 are as described above.

Kondo et al. do not specifically teach providing a substrate comprising a layer of an oxide material to be contacted with an adhesive layer. However, Kijima et al. teach providing a layer of silicon dioxide (SiO_2) (2) on the surface of a silicon substrate (1), where the silicon dioxide layer comes into contact with an adhesive layer (3) (Kijima: abstract; Drawing 1).

It would have been obvious to provide a silicon dioxide layer, as Kijima et al. taught, and one would have been motivated to do so to have an insulator layer to protect the silicon substrate (Kijima: paragraph 0010).


Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Mazumdar whose telephone number is (571) 272-6019. The examiner can normally be reached on 8:00 AM - 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


SM


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